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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,768	03/07/2002	Dieter Kress	2147.GLE.PT	8295

26986 7590 07/24/2003

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EXAMINER

WALSH, BRIAN D

ART UNIT PAPER NUMBER

3722

DATE MAILED: 07/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

8c

# Office Action Summary

Application No.

10/092,768

Applicant(s)

KRESS ET AL.

Examiner

Brian D. Walsh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 9-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 March 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

The Examiner notes that references Alexander, IV (U.S. Pat. No., 6,379,087) and Jones et al. (U.S. Pat. No. 3,754,309), as indicated by Applicant in the letter, paper no. 10, filed 11 July 21, 2003, were not included on form 892 of the Office Action, paper no 9, filed 01 July 21, 2003. Included herewith is a corrected Office Action including proper citation of the above mentioned references. The rejections based on 35 USC 112, 102 and 103 are identical to the previous Office Action. The Examiner apologizes to Application for the inconvenience.

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the prism clamping lug of claims 17, 23 and 28 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. The Examiner notes that a clamping lug is shown, but no structure was found in any of the drawings, clamping lug or otherwise, that would qualify as a prism or even substantially prismatic in configuration.

Similarly, the "grooves" of claim 26 must be shown or deleted from the claims.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 17 and 20 – 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims will be examined as best understood.

Claims 17, 23 and 28 include a limitation that the clamping lug is configured as a prism. However, The New Merriam-Webster Dictionary defines a “prism” as “A solid whose sides are parallelograms and whose ends are parallel and alike in shape and size.” The element referred to as a “prism” clamping lug in the drawings, element 13, clearly has rounded sides which eliminates it as a prism. It also appears in the drawing that the clamping lug does not have ends that are alike in shape and size.

Claims 20 and 24 begin with “A tool according to claim for material-removing...” It appears that these claims were modified from a previously dependent claim and were intended to be independent. For purposes of this examination claims 20 and 24 were assumed to be independent and written as “A tool for material-removing...”

Regarding claim 26, “grooves” lacks proper antecedent basis. The Examiner notes that a single groove is disclosed in claim 24, not a plurality of grooves.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 9, 15, 17 – 19 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones et al.

Regarding claim 9, Jones et al. discloses a cutting insert and clamping arrangement for a cutting tool system comprising a blade plate (hereinafter “cutting insert”) (22) held by a clamping lug (hereinafter “clamp”) (42), the cutting insert having a front side (24, referred to as a “top wall” by Jones et al.) and a groove (38) provided on the front side in which the clamp engages (Col. 2, lines 42 – 44).

Regarding claims 15 and 26, it is clear in figure 2 that the groove (38) extends over the entire width of the cutting insert (22).

Regarding claim 17, Jones et al. discloses a clamp (42) that is configured as a prism.

Regarding claim 18, Jones et al. discloses the base body (10) has a projection (14) in the area of the cutting insert which serves as a support.

Regarding claim 19, Jones et al. discloses the base body is configured as one piece (see figure 1).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 10, 11, 20, 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. in view of Minshall.

Regarding claims 10, 11 and 20 Jones et al. discloses all of the elements as set forth in the above rejections, however, Jones et al. fails to specifically set forth the dimensional characteristics regarding the transverse groove in the top surface of the cutting insert.

Regarding claims 21 and 23, Jones et al. discloses the elements as set forth in the above rejections.

Minshall discloses a cutting insert (21) including a groove (32) on the top (31) of the insert that has angle of approximately  $10^{\circ}$ . Please refer to figure 4.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the groove in the cutting insert of Jones et al. to have an angle of about  $10^{\circ}$  as taught by Minshall since Minshall inherently teaches the use of this angle to provide a surface to engage a clamping arrangement in order retain the insert within the tool.

Furthermore, Jones et al. discloses the same invention except for the specific dimensional characteristics of the groove (angles). It would have been obvious to one of ordinary skill in the art at the time the invention was made to select whatever groove dimensions were appropriate since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimal or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

5. Claims 12, 16 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al in view of Alexander.

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Jones et al. discloses all of the elements as set forth in the above rejections, however, Jones et al. fails to disclose the cutting insert, viewed from above, is essentially in triangular form.

Alexander discloses a variety of cutting insert shapes as well as a variety of cutting insert recess shapes for a clamping arrangement in a tool holder. Alexander discloses a cutting insert (10) with a recess for a clamping arrangement having walls of the recess that are sloped in a cutting insert that is configured essentially as a triangle (see figures 1, 4 and 5) (Col. 5, lines 18 – 21). Furthermore, it is clear in figures 1, 4 and 5 that the recess lies within an incircle of the cutting insert.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the insert of Jones et al. to be of an essentially triangular shape, or any other shape for that matter, since Alexander teaches the shape of an insert will vary depending on the specific needs of the application (Col. 5, lines 18 – 21).

6. Claims 13, 14, 22, 25, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. in view of Alexander and in further view of Minshall.

Regarding claims 13, 14 and 25, Jones et al. and Alexander disclose all of the elements as set forth in the above rejections, however, Jones et al. and Alexander fail to specifically set forth the dimensional characteristics regarding the transverse groove in the top surface of the cutting insert.

Regarding claims 22, 27 and 28, Jones et al. and Alexander discloses all of the elements as set forth in the above rejections.

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Minshall discloses a cutting tool system similar to the instant invention wherein a cross-sectional view of the cutting insert (see figure 4) clearly shows a groove (32) that is approximately  $10^{\circ}$ .

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the groove in the cutting insert of Jones et al. or the recess of Alexander to have an angle of about  $10^{\circ}$  as taught by Mapal since Mapal inherently teaches the use of this angle to provide a surface to engage a clamping arrangement in order retain the insert within the tool.

Furthermore, Jones et al. and Alexander disclose the same invention except for the specific dimensional characteristics of the groove (angles). It would have been obvious to one of ordinary skill in the art at the time the invention was made to select whatever groove dimensions were appropriate since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimal or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fors, McCreery, Luck, Lyon et al., "Mapal Fab Praezision" (German Patent Application No. DE 19521599 A1), Kress and Erickson all disclose insert clamping arrangements similar to the instant invention.



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*Faxing of Responses to Office Actions*

8. In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703) 872-9302. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the Examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the Examiner.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Walsh whose telephone number is (703) 605-0638. The examiner can normally be reached on Monday - Friday 7:30 A.M. to 4:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea Wellington can be reached on (703) 308-2159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



BDW

July 21, 2003



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